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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,922	04/26/2000	John Albert Kembel	10351-0004	1665
43785	7590	03/06/2007	EXAMINER	
JONATHAN A. SMALL JAS IP CONSULTING 343 SECOND STREET SUITE F LOS ALTOS, CA 94022			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/06/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/558,922	KEMBEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 November 2006.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 32 and 35-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 32 and 35-43 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Amendment received on 11/28/2006 has been entered. Claims 32 and 35-43 are pending. Claims

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 32 and 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, US Patent No. 5,761,662 and further in view of Furst, US Patent No. 6,297,819.

4. As to independent claims 32 and 39, Dasan discloses a method of providing content to a user, comprising:

receiving a request for the content (Fig. 6 and col. 6, lines 20-37: user can enter a user name in field 602 and then click on either icons 604, 606 or 610 to request for content for the specific user name);

in response to the request, retrieving information usable by a computing device to present data that is programmed in a format readable by a Web browser program

Art Unit: 2176

(Figs. 6&10, col. 3, line 35 – col. 4, line 7, col. 6, lines 38-52 and col. 7, lines 42-60: in response to the user selection icon 604 in Figure 6, retrieving a user interface for editing a user profile is displayed on screen 1000, and the user interface for editing is supported by a browser); wherein the information includes instructions for invoking a computing device resident process executable and a definition that defines at least in part a functionality and an appearance of a user interface (col. 7, lines 42-60 and Fig. 10) and

transmitting the information (col. 7, lines 42-60).

However, Dasan does not explicitly disclose the format readable a Web browser program outside of a window of a Web browser program, the computing device resident process executable independent of a Web browser and the user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented.

Furst discloses that as is well known, the web browser operates to display in response to user input, web pages in one or more windows (the format readable a Web browser program outside of a window of a Web browser program) (col. 4, lines 22-38). Furst also discloses in col. 4, line 57 – col. 5, line 11 that when the users request the web browser, the client 124 is initiated, the client 124 is a thin shell for an embedded web browser, whose function is to display web pages sent by the System, the System and its component tools operate to create web pages that parallel or shadow actual web pages, which exist outside and independent of the System and its tool. In addition, Furst discloses that the System appears to travel with the users as the user browses the

web, and this enables the user to find at every web site additional functionality that is independent of the web site (col. 2, line 55 – col. 3, line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to include the format readable a Web browser program outside of a window of a Web browser program, the computing device resident process executable independent of a Web browser and the user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented. Since Furst discloses that the System appears to travel with the users as the user browses the web, and this enables the user to fine at every web site additional functionality that is independent of the web site, thus the System enables users to communicate with other web site visitors in a context directly relevant to whatever site the user is visiting or the user can have access to information and services related to, but independent of the control of the web site the user is visiting.

5. As to dependent claims 35 and 40, Dasan and Furst (Dasan-Furst) disclose wherein at least a portion of the user interface is a frame within which the results of the computing device resident process are presented (Furst, col. 11, lines 55-64: when the component tool (frame) is activated from the icon bar in a context that includes a fill-in-web-based form, the tool autofills form with the information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to include at least a portion of the user interface is a

frame within which the results of the computing device resident process are presented since the component tool operates to create web pages that parallel or shadow actual web pages which exist outside and independent of the component tool).

6. As to dependent claims 36 and 41, Dasan-Furst disclose wherein at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented (Dasan, col. 7, lines 43-60; Furst, col. 2, line 65 – col. 3, line 6, and col. 9, line 9 – col. 12, line 65: each application tool has certain appearance shown by its tool user interface window which is defined by a web page or a wide variety of forms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to include at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented. Furst suggests that the component tool can be customized for each user, so users can choose to select and enable only the component tools they find useful).

7. As to dependent claims 37 and 42, Dasan-Furst disclose wherein the definition is provided by a Web content provider, thereby enabling the Web content provider to control at least in part a functionality and an appearance of the frame when rendered (Dasan, col. 6, lines 11-19 and col. 6, line 61 – col. 7, line 41).

8. As to dependent claim 38, Dasan-Furst disclose wherein the computing device resident process is provided by the Web content provider (Dasan, col. 6, line 11 – col. 7, line 41).

9. As to dependent claim 43, Dasan-Furst disclose wherein the computing device resident process, content data, and the definition are provided by the Web content provider, thereby enabling the user interface to integrate seamlessly with the results of the computing device resident process and content data (Dasan, col. 6, line 11 – col. 7, line 41).

### ***Response to Arguments***

In the remarks, Applicant(s) argued in substance that

A) Neither reference discloses or suggests that web content be displayed outside of a window of a web browser program (see page 7 of remarks).

In reply to argument A, Furst discloses in col. 4, line 57 – col. 5, line 11 that when the users request the web browser, the client 124 is initiated, the client 124 is a thin shell for an embedded web browser, whose function is to display web pages sent by the System, the System and its component tools operate to create web pages that parallel or shadow actual web pages, which exist outside and independent of the System and its tool. Furst also discloses that the System appears to travel with the users as the user browses the web, and this enables the user to find at every web site additional functionality that is independent of the web site (col. 2, line 55 – col. 3, line 6).

B) Neither Dasan nor Furst teach the feature “the information includes instructions for invoking a computing device resident process” (see page 8 of remarks).

In reply to argument B, Dasan discloses in Fig. 10 that the user selects or clicks on any icons 1002-1010 for topic selections (the information), and then the user clicks on generate icon 1018 (instruction), and the newspaper is generated based upon the topic selections (Dasan, col. 7, lines 42-60).

C) Neither Dasan nor Furst provide a process executable independent of a Web browser application (see page 9 of remarks).

In reply to argument C, Furst discloses in col. 4, line 57 – col. 5, line 11 that when the users request the web browser, the client 124 is initiated, the client 124 is a thin shell for an embedded web browser, whose function is to display web pages sent by the System, the System and its component tools operate to create web pages that parallel or shadow actual web pages, which exist outside and independent of the System and its tool. Furst also discloses that the System appears to travel with the users as the user browses the web, and this enables the user to find at every web site additional functionality that is independent of the web site (col. 2, line 55 – col. 3, line 6).

D) Neither of reference teaches or suggests that the information include a definition the appearance of a user interface in which data is displayed.

In reply to argument D, Dasan discloses in col. 7, line 61 – col. 8, line 39 that the process for actually creating the newspaper functions as a full-text retrieval system which is controlled by the context such as source(s) and date(s) and corresponding search term(s) specified in each of the selection topics, and Fig. 11 shows the results of

the creation of a personal newspaper displayed at the client as a result of the full-text searching, and each of the topics from user's selection is listed in a first level heading (an appearance) such as 1104, 1106, 1108, etc, which are followed by second level headings such as 1106a-1106c, 1108a-1108l, etc.)

E) The combination of Dasan and Furst is improper in which there is no motivation to combine Dasan and Furst (see page 11 of remarks).

In response to applicant's argument E that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Dasan discloses an automatic method and system for retrieving information based on a user-defined or user-selections, the server engages a first application, which examines a database of information and retrieves the information based on the user-defined. Furst discloses a system that monitor for a user while the user is browsing the web and enables the user to obtain and interact with context-sensitive services and information based on the user's browsing activity, which is similar to system of Dasan. Thus it would have been obvious in the knowledge generally available to one of ordinary skill in the art at the time the invention was made to modify or combine the teachings of Furst with Dasan since they both are from the same field of

endeavor. Since Furst discloses that the System appears to travel with the users as the user browses the web, and this enables the user to find at every web site additional functionality that is independent of the web site, thus the System enables users to communicate with other web site visitors in a context directly relevant to whatever site the user is visiting or the user can have access to information and services related to, but independent of the control of the web site the user is visiting.

10. Applicant's arguments filed 11/28/2006 have been fully considered but they are not persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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